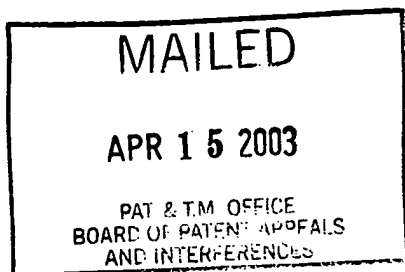




## UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Judge Mark Nagumo  
Telephone: (703) 308-9797  
Facsimile: (703) 305-0942



Applicant: KIMURA  
Application No.: 09/678,218  
Filed: 09/29/00  
For: 1,2-DIPHENYLPYRROLE DERIVATIVES,  
THEIR PREPARATION AND THEIR THERAPEUTIC  
USES  
Accorded benefit: Patent 5,908,858, granted 06/01/99  
based on Application 08/824,75, filed 03/26/97  
Japanese Patent 08-083562, filed 04/05/96

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,103.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

  
MARK NAGUMO  
Administrative Patent Judge

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 1

Filed by: Mark Nagumo  
Administrative Patent Judge  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-305-0942

Filed  
15 April 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

ISH K. **KHANNA**,  
RICHARD M. WEIER, and YI YU

Junior Party  
(Patent No. 5,935,990),

v.

TOMIO **KIMURA**,  
YASUO NOGUCHI, AKIRA NAKAO, KEISUKE SUZUKI,  
SHIGERU USHIYAMA, AKIHIRO KAWARA,  
and MASAACKI MIYAMOTO

Senior Party  
(Application 09/678,218).

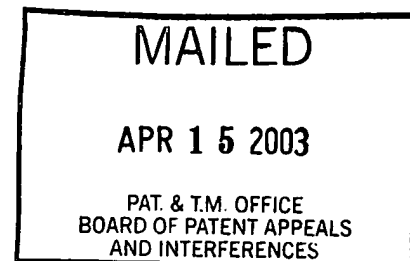
Patent Interference 105,103 (NAGUMO)

**NOTICE DECLARING INTERFERENCE**  
(37 CFR § 1.611)

**Part A. Declaration of interference**

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties.

Details of the application and patents, count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.



**Part B. Judge designated to handle the interference**

Administrative Patent Judge Mark Nagumo has been designated to handle the interference. 37 CFR § 1.610(a).

**Part C. Standing order**

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

**Part D. Conference call to set dates**

A telephone conference call to set dates for taking action in the interference is scheduled for **2:30 p.m. on June 10, 2003** (the call will be initiated from the PTO).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

**Part E. The parties involved in this interference are:**

Junior Party

Named inventors: Ish K. Khanna, USA  
Richard M. Weier, USA  
Yi Yu, USA

Patent: 5,935,990 (issued August 10, 1999)  
filed December 9, 1997<sup>1</sup>

Title: Substituted pyrrolyl compounds for the  
treatment of inflammation

Assignee: Pharmacia Corp.

Accorded Benefit: 60/032,688  
filed December 10, 1996

Attorneys: See last page

Address: See last page

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<sup>1</sup> Khanna claims the benefit under 35 U.S.C. § 119(e) of U.S. provisional application 60/032,688, filed December 10, 1996.

Senior Party

Named Inventors: Tomio Kimura, Japan  
Yasuo Noguchi, Japan  
Akira Nakao, Japan  
Keisuke Suzuki, Japan  
Shigeru Ushiyama, Japan  
Akihiro Kawara, Japan  
Masaaki Miyamoto, Japan

Application: 09/678,218  
filed September 29, 2000

Title: 1,2-Diphenylpyrrole derivatives, their  
preparation and their therapeutic uses

Assignee: Sankyo Co., Ltd.

Accorded Benefit: (i) U.S. Pat. No. 5,908,858  
issued June 1, 1999,  
filed March 26, 1997<sup>2</sup>

(ii) JPN 8-083,562  
filed April 5, 1996

Attorneys: See last page

Address: See last page

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<sup>2</sup> Kimura claims the benefit under 35 U.S.C. § 119 of Japanese application 8-033,562, filed April 5, 1996. A certified copy of that document is in the parent application file. A certified translation was filed as Paper 4 in the present application.

**Part F. Count and claims of the parties**

Count 1

The compound as defined by claim 1 of Khanna's 5,935,990 patent,

or

the compound as defined by claim 13 of Kimura's 09/678,218 application.

The claims of the parties are:

Khanna 1-31

Kimura 13-24, 28, 29, 31-33, 35-37, 40, 41, 43-86.

The claims of the parties that correspond to Count 1 are:

Khanna 1-4, 6-13, 15-22, 24-31

Kimura 13-24, 28, 29, 31-33, 35-37, 40, 41, 43-86.

The claims of the parties that do not correspond to Count 1, and therefore are not involved in the interference, are:

Khanna 5, 14, 23

Kimura none.

**Part G. Heading to be used on papers**

The following heading shall be used on papers filed in the interference. See § 18 of the STANDING ORDER.

Paper \_\_\_\_<sup>3</sup>

Filed on behalf of [name of party]  
By: Name of lead counsel, Esq.  
Name of backup counsel, Esq.  
Street address  
City, State, and Zip-Code  
Tel:  
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

ISH K. **KHANNA**,  
RICHARD M. WEIER, and YI YU

Junior Party  
(Patent No. 5,935,990),

v.

TOMIO **KIMURA**,  
YASUO NOGUCHI, AKIRA NAKAO, KEISUKE SUZUKI,  
SHIGERU USHIYAMA, AKIHIRO KAWARA,  
and MASAACKI MIYAMOTO

Senior Party  
(Application 09/678,218).

Patent Interference 105,103 (NAGUMO)

TITLE OF PAPER

<sup>3</sup> Leave a blank line because the board assigns the paper number.

**Part H. Summary of dates for taking action**

Times for taking action are set out in the following sections of the STANDING ORDER:

1. § 7: date for identifying lead and backup counsel.
2. § 8: date for identifying any real party in interest.
3. § 9: date for requesting copies of involved and benefit applications and patents.
4. § 17: date for filing list of proposed preliminary motions.
5. § 19: date for accomplishing certain discovery.
6. § 20: date for filing clean copy of claims.
7. § 21: date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
8. § 23: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
9. § 33: date for objecting to admissibility of evidence.
10. § 34: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
11. § 35: dates when cross-examination can take place.
12. § 45: dates for taking action with respect to settlement discussions



**Part I. Order form for requesting file copies**

**FILE COPY REQUEST**

Interference 105,103 (Nagumo)

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. \_\_\_\_\_
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

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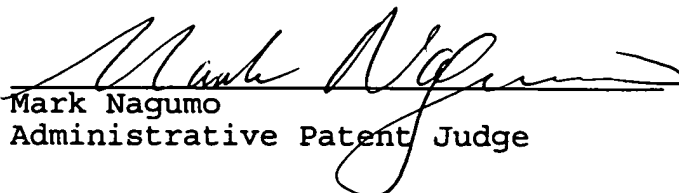
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Telephone, including area code: \_\_\_\_\_

Part J. Signature of administrative patent judge

  
Mark Nagumo  
Administrative Patent Judge

Enc:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in  
the preliminary motion phase of the interference (ORDERPM6)

Copy of order used for setting times for taking action in  
the testimony and briefing phases of the interference  
(ORDERTE6)

Copy U.S. Patent 5,935,990

Copy of claims of 09/678,218

DECLARE mn 007.wpm  
Revised September, 2000  
(replaces DECLARE.006.1)

Interference 105,103  
Khanna v. Kimura

Paper 1

cc (via Federal Express):

Attorney for Khanna  
(Real party in interest, Pharmacia Corp.)

Pharmacia Corp.  
Global Patent Department  
Post Office Box 1027  
St. Louis, MO 63006

Address for overnight delivery:

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Global Patent Department  
575 Maryville Centre Drive  
St. Louis Mo 63141

Tel: (314)274-1000  
Fax: (314)274-7256  
E-mail: currently unknown

Attorney for Kimura  
(Real party in interest, Sankyo co., Ltd.)

Herbert Goodman, Esq.  
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC  
767 Third Avenue  
25th Floor  
New York NY 10017-2023

Address for overnight delivery:

Herbert Goodman, Esq.  
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25th Floor  
New York NY 10017-2023

Tel: (212)319-4900  
Fax: (212)319-5101  
E-Mail: currently unknown

**INTERFERENCE DIGEST**

Interference No. 105,103

Paper No. 25

Name: Tomio Kimura et al.

Serial No.: 09/678,218

Patent No.

Title: 1,2-DIPHENYLPYRROLE DERIVATIVES, THEIR PREPARATION AND THEIR  
THERAPEUTIC USES

Filed: 09/29/00

Interference with Khanna et al.

**DECISION ON MOTIONS**

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

**FINAL DECISION**

Board of Patent Appeals and Interferences, favorable Dated, 2/23/05

\_\_\_\_\_

Court, \_\_\_\_\_ Dated, \_\_\_\_\_

**REMARKS**

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

This should be placed in each application or patent involved in interference in addition to the interference letters.